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OFFICE OF PETITIONS

In re Application of :
Middelberg et al. :
Application No. 10/034,853 : ON PETITION
Filed: December 28, 2001 :
Attorney Docket No. 1174/117/2:

This is a decision on the PETITION TO REVIVE APPLICATION ABANDONED UNAVOIDABLY filed June 30, 2005. Applicants request, in the alternative, that the application be revived based on unintentional delay.

The petition under § 1.137(a) is **DISMISSED**.

The petition under § 1.137(b) is **GRANTED**.

The above-identified application was held abandoned for failure to reply to the Notice Regarding Drawings mailed December 2, 2004. The Notice set a two-month non-extendable time period for response. A Notice of Abandonment was mailed on April 18, 2005. By decision mailed June 27, 2005, a prior petition to withdraw the holding of abandonment filed June 20, 2005, was dismissed.

In response, applicants filed the instant petition, asserting that the delay was unavoidable. A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(l);

(3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

The petition includes the response to the Notice Regarding Drawings and payment of the fee under § 1.17(1). As this application was filed after June 8, 1995, no terminal disclaimer is required on petition to revive.

However, the petition is not grantable because requirement (3) above is not met.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was

"unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

A delay is not unavoidable because an applicant was waiting for a response from the Office, and while they waited the period for reply expired. The patent law requires an applicant to prosecute a patent application with reasonable diligence. See Planing Machine Co. v. Keith, 101 U.S. 479 (1879), quoted in In re Takeo, 17 U.S.P.Q. 2d (BNA) 1155 (Comm'r Pat. & Trademarks Feb. 27, 1990). The diligence required pertains to the act(s) required of applicant to respond to any outstanding Office action or requirement so that the PTO can take appropriate action in completing the examination of the application. In re Takeo, 17 U.S.P.Q.2d (BNA) 1155 (Comm'r Pat. & Trademarks Feb. 27, 1990). Thus, the failure to act does not reflect "unavoidable" delay. An application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Moreover, delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute unavoidable delay. See Haines, 673 F. Supp. At 317, 5 U.S.P.Q.2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). (Cf. In re Decision dated February 18, 1969, 162 U.S.P.Q. 383 (Comm'r Pat. 1969; interpretation of rule 7 was not unreasonable; hence, resultant delay in prosecution may be considered unavoidable). A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner's arguments and evidence have been considered, but not found persuasive. Applicants have not made an adequate

showing of unavoidable delay. Applicants acknowledge not responding to the Notice Regarding Drawings. In essence, applicants contend that their failure to respond should be excused because the drawing figure required by the Notice was filed on September 23, 2003. Furthermore, receipt of the drawing was acknowledged by Office action dated April 8, 2004, and Notice of Allowance mailed on October 15, 2004. Moreover, petitioner states that he was advised by a draftsman by telephone on December 9, 2004 that the drawing was present in the application. Further, on April 26, 2005, another Office employee advised him that the Notice of Abandonment had been mailed incorrectly and to file a petition to withdraw abandonment. Subsequently, the petition to withdraw was filed, but dismissed.

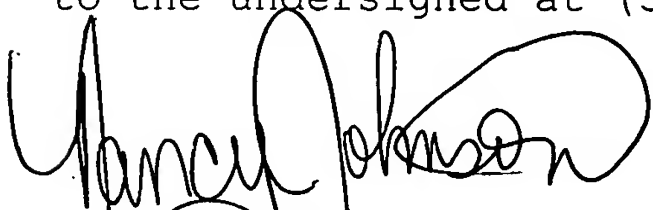
There is no dispute that a Notice Regarding Drawings was mailed to and received by applicants. However, applicants did not file a response to the Notice, even though the Notice advised that failure to respond would lead to abandonment of the application. As indicated in the decision dismissing the petition to withdraw, calling the Office was not sufficient. The Office had advised applicants in writing that drawings were required within a specified time period. The diligence required of applicants in this situation was to respond to the Office with the drawings so that the Office could complete issuance of the application. Alternatively, given applicants interpretation of the Notice, it would have been proper to respond in writing within the time period for response with their showing of prior filing. At that time, the Office could have furthered processing of the application by responding to applicants with clarification that the drawing sheet was not present in the case. Applicants' reliance on telephone calls and oral advice does not excuse their failure to take action in response to the requirement set forth by the Office.

While the showing of record is not sufficient to satisfy the requirements of § 1.137(a), applicants have met the requirements of § 1.137(b). The petition includes the reply required to the outstanding Office action or notice. The petition fee set forth in 37 CFR 1.17(m) has been charged to Deposit Account No. 50-0426, as authorized. 37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." The statement contained in the instant petition varies from the language

required by 37 CFR 1.137(b)(3). The statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition. As previously stated, no terminal disclaimer is required.

The Office of Patent Publication has been advised of this decision. The application is, thereby, forwarded for processing into a patent.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized loop at the end.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions